

REMARKS

Claims 1 to 52 were pending in the application at the time of examination. Claims 1 to 17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1 to 17, 19 to 34, 40, and 41 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1 to 52 stand rejected as anticipated.

Applicant notes that responsibility for the above application has been transferred to the undersigned attorney. Please address all further correspondence to the undersigned attorney. A revocation of attorney and appointment of new attorney has been filed under separate cover.

Applicant has amended the description to correct typographical and grammatical errors.

Claims 1 to 17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner stated in part "Claims 1 to 17 are non-statutory because they are directed to a method without recitation of a computer or a computer readable-medium embodying the method in order to produce 'a useful, concrete and tangible result.'"

Applicant notes that the preamble of Claim 1 recited a computer system environment in which the method was executed. Apparently, the Examiner gave no weight to the recitation in the preamble. Applicant amended the preamble to simply recite that the method is performed "In a computer system." The deleted elements in the preamble have been moved into the body of the claim. Applicant requests reconsideration and withdrawal of the §101 rejection of each of Claims 1 to 17.

In the 35 U.S.C. §112 second paragraph rejection of Claim 1, the Examiner stated:

Claim 1 rejected [Sic] under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is impossible for Applicant to respond to this rejection, because no information is given as to the basis for the rejection. Accordingly, Applicant requests reconsideration and withdrawal of the §112, second paragraph rejection of Claim 1.

In the 35 U.S.C. §112 second paragraph rejection of Claims 2 to 17, the Examiner stated "it is unclear to what method it is referring." Applicant has amended each of Claims 2 to 17 to read "The method." Applicant requests reconsideration and withdrawal of the §112, second paragraph rejection of Claims 2 to 17.

In the 35 U.S.C. §112 second paragraph rejection of Claims 19-34 the Examiner stated "it is unclear to what tool it is referring." Applicant has amended each of Claims 19 to 34 to read "The tool." Applicant requests reconsideration and withdrawal of the § 112, second paragraph rejection of Claims 19 to 34.

In the 35 U.S.C. §112 second paragraph rejection of Claims 6, 23, 40, the Examiner stated "it is unclear to which group of computer programs it is referring." Applicant respectfully traverses the § 112, second paragraph rejection of Claims 6, 23, 40.

Claim 6 recites possible user selectable options. Until an option is selected, it not associated with any particular group of computer programs. The Examiner appears to be dissecting the claim and not reading each line as an element. Applicant respectfully submits that when Claims 6, 23, and 40 are read in view of the specification, those of skill in the art will be able to determine the metes and bounds of each of the claims. Applicant requests reconsideration and withdrawal of the §112, second paragraph rejection of each of Claims 6, 23, and 40.

In the 35 U.S.C. §112 second paragraph rejection of Claims 7, 24, 41, the Examiner stated "it is unclear to which user-selectable option it is referring." Again, the Examiner apparently has failed to read the claim language as a whole. The claim language recited "a user-selectable option being selected," i.e., the selected user-selectable option. Nevertheless, Applicant has amended each of Claims 7, 24, and 41 to recite "a selected user-selectable option." Applicant respectfully requests reconsideration and withdrawal of the § 112, second paragraph rejection of Claims 7, 24, 41.

Applicant has amended each of Claims 36 to 51 to read "The apparatus." This was done in view of the rejection, for example, of Claims 19 to 34.

Claims 1, 8 to 14, 16, 18, 25 to 29, 31 to 35, and 42 to 52 are also amended to correct informalities. In particular, the amendments consistently recite the elements. Since these amendments fix informalities, Applicant respectfully submits that the amendments do not affect the patentability of the claims.

Claims 1 to 52 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication Number 2003/0182650, hereinafter referred to as "Smith."

Applicant respectfully traverses the anticipation rejection in view of Smith. Applicant respectfully submits that the Examiner has failed to establish that Smith is a proper reference. Smith is a continuation-in-part application that was filed on March 5, 2003, which is after Applicant's filing date of June 11, 2001. It is well established that a continuation-in-part application has two filing dates. The Examiner has failed to demonstrate what new material was added to the March 5, 2003 filing of Smith, and which material was in the original filing of February 14, 2000. Thus, Smith is a proper reference only if the material relied upon by the Examiner was in the originally filed application of Smith. Any

new material added by Smith in the March 5, 2003 filing cannot be relied upon by the Examiner as it is after Applicant's filing date. The Examiner has failed to demonstrate or even make an assertion that the material was in the original application of Smith. Accordingly, Applicant respectfully submits that at best the rejection is incomplete, and may in fact be improper. Applicant requests that the Examiner cite with specificity the material relied upon by the Examiner in the proper document, i.e., U.S. Patent Application Serial No. 09/503,485, or remove the reference.

To move the prosecution forward, Applicant will address the rejection. However, this is not to be construed as an admission by Applicant that Smith is a proper reference. To support an anticipation rejection, the MPEP requires that a reference:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." . . . "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

MPEP § 2131, Eighth Edition, p. 2100-73 (May 2004)

Smith taught:

[0043] This source code 10, 12 together with the user selected build option parameters are supplied as inputs to a compiler 14 and an assembler 16 respectively.

Smith, paragraph [0043], page 2.

Smith further taught:

[0051] The groups of source code entities 18, 20 are supplied as one input to a linker 22. In relation to the mechanism of at least the preferred embodiments of this invention the linker 22 serves the function of identifying an appropriate library of machine code entities within a collection of libraries 24 and then matching the different source code entities to the appropriate machine code entities within the selected library. The output from the linker 22 is a machine code image 25 (group of machine code entities) that forms an executable program upon the target processor apparatus.

Smith, paragraph [0051], page 3.

Thus, the user, according to Smith, supplies source code and build option parameters. A linker generates a machine code image. This fails to teach, for example, "designating a capable computer in response to the user's selection of a computer" as recited in Claim 1. The rejection admits this fact because the Examiner cited to a "selected library of machine code entities." However, the above quotation from Smith shows that it is a linker and not a user selection that performs this function. Further, this fails to teach anything concerning a computer in a plurality of computers. Thus, Smith fails to teach "The identical invention . . . in as complete detail as is contained in the . . . claim," as required by the MPEP. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

Claims 2 to 17 depend from Claim 1 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 17.

Claim 18 recites in part "a computer selector, responsive to the user's selection of a computer" Claim 18 stands rejected under the same rationale as Claim 1. The above

comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of a computer selector, and moreover, as quoted above, Smith teaches a different tool. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 18.

Claims 19 to 34 depend from Claim 18 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 19 to 34.

Claim 35 recites "means for designating a capable computer in response to the user's selection of a computer" Claim 35 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of this means. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 35.

Claims 36 to 51 depend from Claim 18 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 36 to 51.

Claim 52 recites "designating a capable computer in response to the user's selection of a computer" Claim 52 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of this means. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 52.

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Appl. No. 09/879,440
Amdt. dated September 7, 2004
Reply to Office Action of June 7, 2004

Claims 1 to 52 remain in the application. Claims 1 to 52 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

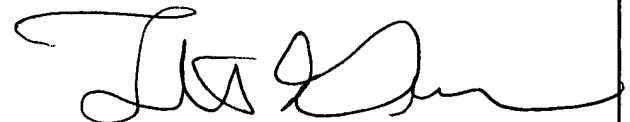
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 7, 2004.



Attorney for Applicant(s)

September 7, 2004
Date of Signature

Respectfully submitted,



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